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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/882,675      | 06/15/2001  | Dennis J. O'Rear     | 005950-677          | 9491             |

7590 09/10/2003  
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Alexandria, VA 22313-1404

EXAMINER

MCAVOY, ELLEN M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1764

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/882,675

Applicant(s)

O'REAR, DENNIS J.

Examiner

Ellen M McAvoy

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-22 are still rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,392,108 B1 (O'Rear). Although the conflicting claims are not identical, they are not patentably distinct from each other because the method claimed in O'Rear of inhibiting oxidation of a Fischer-Tropsch product comprising the step of adding an effective amount of a temporary antioxidant selected from the group consisting of sulfides, disulfides, polysulfides, mercaptans, or mixtures thereof, to provide a blended product having a final peroxide number of less than 5 ppm after 7 days, results in a product which is indistinguishable from the products of the instant claims.

Applicants response that they will consider submitting a terminal disclaimer once allowable subject matter has been agreed upon has been noted.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-22 are still rejected under 35 U.S.C. 103(a) as being unpatentable over Alward (5,453,211).

Applicant's arguments filed 2 July 2003 have been fully considered but they are not persuasive. As set forth in the previous office action, Alward discloses that the oxidation stability of lubricating oil basestocks and formulated lubricant oils is improved by the addition of minor amounts of tetralins, alkylated tetralins or mixtures thereof, or their combination with organic sulfides to the oil. Alward teaches that suitable lubricating oils may be obtained from any source such as natural naphthenic or paraffinic petroleum hydrocarbon oils and wax isomerate oils produced by the hydro-isomerization of slack waxes or hydrocarbon synthesis waxes such as Fischer-Tropsch waxes. See column 1, lines 5-18 and column 2, lines 47-61. Alward teaches that an amount of organic sulfide ranging from 0 to 0.1 weight %, based on the elemental sulfur content of the organic sulfide, may be used in combination with the tetralin or alkyl-substituted tetralin. Alward teaches that if the lubricating oils have been severely hydrotreated to reduce their inherent sulfur contents, the addition of organic sulfides of low to moderate molecular weight and low boiling point may be desirable which may later be removed by distillation from the oil prior to the oil being combined with commercial additive packages to

produce a formulated oil. See column 3, lines 5-20. Thus, the examiner maintains the position that Alward clearly meets the claim limitations of a Fischer-Tropsch product containing a temporary organic sulfide antioxidant, and that applicant's open-ended claim language "comprising" allows for the addition of other additives to the composition such as the tetralin components of Alward.

Applicant argues that since Alward teaches using organic sulfides only in combination with tetralin or alkyl substituted-tetralin or mixtures thereof, Alward does not teach or suggest adding solely the organic sulfides in an amount such that the product has a peroxide number of less than 5 ppm after 7 days. This is not deemed to be persuasive since applicant's claims do not exclude the addition of the tetralin compounds. As set forth above, the organic sulfide compounds may be any (C<sub>1</sub>-C<sub>24</sub>) (di-) alkyl or (di-) aryl sulfide compounds which may be the same as those sulfides claimed, and Alward specifically teaches removing the sulfides by distillation if so desired.

The claimed rejections under 35 USC 103 over the Berlowitz references made in the previous office action have been withdrawn in view of applicant's arguments.

#### ***Conclusion***


**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (703) 308-2510. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (703) 308-6824. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Ellen M. McAvoy  
Primary Examiner  
Art Unit 1764

EMcAvoy  
September 8, 2003